

REMARKS

The specification is amended at page 75, line 24 to correct an obvious typographical error where constituent (A2) was mis-labeled as “(A1)”. This amendment is well-supported by the subsequent portions of the paragraph where the sub-constituents were set forth as “(a2x)”, combined with the previous paragraph where the same (a2x) sub-constituents were identified as sub-constituents of constituent (A2). Also, constituent (A1) had already been previously described in the specification at page 70, line 10 through page 73, line 4.

Upon entry of the present amendment, claims 3, 18, 19, 21, 22, 25, 26, 28, and 42-62 will be pending in the application. Claims 3, 42, and 53 are amended to specify that the constituent (a23) is 20-89% by weight water when at least 1-70% inorganic pigment is present. Support for this amendment is found at page 75, lines 11-12 and 16. Claim 42 is also amended to add “by weight” with respect to the defined amount of constituent (a13). This amendment is supported in the specification at page 70, lines 21-23. Claims 57-60 are added directed to embodiments of the invention where the pigment (a12) comprises metal flake (claims 57 and 59) and embodiments where the pigment (a12) comprises aluminum flake (claims 58 and 60). Support for this amendment is found in the specification at page 54, lines 19-22 and page 2, lines 1-6. The page 54 citation discloses embodiments where the pigment (a12) is metal flake, including aluminum flake pigments like the disclosed aluminum bronze pigments. The page 2 citation teaches that a problem with prior art approaches where aluminum flake pigment is disposed in an aqueous pigment module, as disclosed in EP 608,773 (equivalent to US 5,672,649 of Brock et al. cited in the Office Action), is the formation of hydrogen. Clearly, this problem is solved in the present invention by incorporating effect pigment such as aluminum flake into the ‘water-free’ (i.e., less than 5% water) module (I), and it is toward such embodiments that the aluminum flake claims 58 and 60 are directed. Claims 61 and 62 are added to limit the module (II) to color pigments, analogous to what was previously done with claim 48 with respect to module (I).

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Entry of the above amendments without prejudice is respectfully requested, and reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 3, 18, 19, 21, 22, 25, 26, 28, and 42-56 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.**

The Office Action asserts that the support in the specification for the claimed content limitation reference for (a23) when “(a22) is from 1 to 30% by weight of at least one organic color pigment” refers to (A1), not (A2). The Office Action also asserts that the parameter for inclusion of (a23) as “at least 20% by weight water when” (a22) includes “1 to 30% by weight of at least one organic color pigment” is not shown at pages 75-76 as contended by Applicants. Finally, the Office Action asserts that there is no disclosure of constituent (a13) being 89.5% without “by weight” in claim 42.

This rejection is believed to be obviated by the above amendment, which changes the reference at page 75, line 24 of the specification from constituent (A1) to constituent (A2), changes the definition of constituent (a23) in claims 3, 42, and 53 from “at least 20% by weight water” when (a22) includes “1 to 30% by weight of at least one organic color pigment” to “20-89% by weight water” when (a22) includes “1 to 70% by weight

of at least one inorganic color pigment”, and adds a reference to “by weight” in the description of constituent (a13) in claim 42. Applicants respectfully submit that the specification and the claims are now in agreement, and they request that the rejection be withdrawn.

2. **Rejection of claims 3, 18, 19, 21, 22, 25, 26, 28, and 42-56 under 35 U.S.C. 103(a) as being obvious over Reusmann et al. (U.S. Patent No. 6,403,701), hereafter “Reusmann” taken in combination with Brock et al. (U.S. Patent No. 5,672,649), hereafter “Brock”.**

This rejection is respectfully traversed.

The Office Action asserts that each of the references relied on in the rejection is cited to show the conventionality of each of Applicants’ claimed components (A1), (A2), and III. The Office Action asserts that Reusmann discloses a modular mixing system having a ‘water-free’ (i.e., less than 5% water) pigment module (onto which the Office Action reads Applicants’ component (A1)) and a water-containing aqueous binder module (onto which the Office Action reads Applicants’ component (III)). The Office Action further asserts that Brock discloses an “identical system” (see Office Action, top of page 7) that includes a water-containing pigment module (onto which the Office Action reads Applicants’ component (A2)), and that such a module is “conventional”. Finally, the Office Action argues that it would be obvious to combine Brock’s allegedly conventional water-containing pigment module into the allegedly identical system of Reusmann to arrive at Applicants’ claimed invention. Applicants respectfully disagree.

The Office Action further objects to Applicants’ comments concerning DE A 41 10 520. While Applicants acknowledge that repeated cross-citations and arguments regarding this reference may perhaps somewhat muddy the waters, they respectfully point out that since it was the supposed shortcomings of the ‘520 reference that the Brock reference itself was purporting to overcome (see Brock col. 1, lines 41-67), and that Reusmann itself purports to be an improved variant on ‘520 (see Reusmann at col. 2, lines 37-57), at least some limited reference to ‘520 is appropriate in order to understand the teachings of Brock *as a whole* that are relevant to the issue of whether one skilled in the art would combine Brock’s water-based pigment module into the modular system of Reusmann, as proposed in the Office Action. However, in the interest of

staying focused on the issues, Applicants will make only limited reference to the '520 reference.

The mixing system of the '520 reference contains a 'water-free' pigment module and a water-containing binder module ('water-free' will be used in single quotes since the module actually calls for less than 5% water). Reusmann, like '520, also discloses a mixing system having a 'water-free' pigment module and a water-containing binder module, but purports to offer better condensation-resistance in the final coating by using a particular type of polymer in the binder module. Brock distinguishes over '520 by **replacing** the '*water-free*' pigment module with a *water-containing* effect pigment module (A) (at least 20% water) and an optional *water-containing* color pigment module (C). Brock asserts two main improvements over 'water-free' pigment module systems such as described in '520 (and also described in Reusmann): (1) lower solvent content (see Brock col. 1, lines 57-60) and (2) improved storage stability (see Brock col. 1, lines 61-62). Brock purports to accomplish this by **replacing** the 'water-free' pigment module with water-containing pigment module(s), resulting in a mixing system in which ***each module contains water***. Brock's effect pigment module (A) has at least 20% water (col. 2, lines 8-9), the binder module (B) has at least 15.4% water (see col. 7, lines 22-23 and 31-33, where the 15.4% minimum water content can be calculated using the 20% solids and 0.3:1 solvent:water ratio endpoints), and the optional color pigment-containing dye module (C) also has at least 15.4% water content (see col. 8, lines 9-10 and 12-13). None of Brock's modules could be characterized as 'water-free' (having less than 5% water).

The Office Action asserts that it would be obvious to combine Brock's water-containing pigment module into Reusmann's mixing system to arrive at Applicants' claimed invention because such modules are conventional. Applicants respectfully disagree, pointing out that, far from proposing a 'mix and match' approach, Brock discloses a system where ***both*** an effect pigment module (A) ***and*** a color pigment module (C) are *water-containing*, in the overall context of a system where all the modules contain water. The combination proposed by the Office Action ignores the clear teaching of Brock to **replace** the '520/Reusmann 'water-free' pigment module with water-containing pigment modules, and instead proposes to *leave* Reusmann's 'water-free' pigment module in the system and **adds** only Brock's optional water-containing color pigment

module (C) to Reusmann's system, which of course conveniently arrives at Applicants' claimed mixing system.

Since Applicants' claimed invention requires a color pigment (not an effect pigment) in the water-containing module (A2), one would have to choose Brock's optional color module (C) over the effect module (A) as the 'conventional' module to drop into Reusmann's system in order to arrive at Applicants' invention as proposed by the Office Action. One might question why one skilled in the art wouldn't pick Brock's effect module (A) as the water-containing pigment module to drop into Reusmann's system? If one were to make such a combination, it would clearly result in a system outside the scope of Applicants' invention, which requires a *color* pigment in the water-containing module (A2). Additionally, such a combination would also fail to meet the requirements of certain of Applicants' claims requiring that the 'water-free' module (A1) include an effect pigment or claims that limit the water-containing module (A2) to a color pigment. Alternatively, if one were to pick both of Brock's pigment modules (A) and (C) to drop into Reusmann's system, then why would one skilled in the art want to still keep Reusmann's water-free pigment module at all? If these modules are simply being used for their known purpose as asserted by the Office Action, Applicants submit that there would be no reason to keep the water-free pigment module, since the both color and effect would already be provided by Brock's water-containing pigment modules (A) and (C). Of course, Applicants have *now* discovered (and demonstrated in the application's comparative example) that a system with both a water-containing pigment module and a water-free pigment module unexpectedly provides greater pigment loadings, but no such expectation has been shown in the prior art.

Applicants respectfully submit that no reason or motivation has been shown, absent hindsight gleaned from Applicants' claimed invention, to adopt the selective approach of picking and choosing Brock's components for combination that would be needed to support the Office Action's rejection. Moreover, all of the above imagined combinations go against the clear teaching of Brock of *replacing* the '520/Reusmann 'water-free' pigment module with one or two pigment modules (A) and (C), *both* of which contain water. Accordingly, Applicants respectfully submit that their claimed

invention would not be obvious from the combination of references proposed in the Office Action.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

/MaryEGolota/
Mary E. Golota
Registration No. 36,814
Cantor Colburn LLP
(248) 524-2300

Monday, February 08, 2010
CORRESPONDENCE ADDRESS ONLY

BASF CORPORATION
1609 Biddle Avenue
Wyandotte, MI 48192
Customer No. 77224

MEG/pm